



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,563	09/28/2001	Masaaki Nishikiori	1086.1139CIP	2578

21171 7590 12/05/2005

STAAS & HALSEY LLP
SUITE 700
1201 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

WINTER, JOHN M

ART UNIT PAPER NUMBER

3621

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/964,563

Applicant(s)

NISHIKIORI ET AL.

Examiner

John M. Winter

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1016 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status

Claims 1-16 remain pending.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Response to Arguments

The Applicants arguments filed on September 21, 2005 have been fully considered.

The Applicant states that the claims of the present invention are directed towards a different purpose and are not obvious in view of the prior art.

Examiner responds that as per *Ex parte Clapp*, 227 USPQ 972 (Bd Pat App & Int) "To support conclusion that claimed combination is directed to obvious subject matter, the references must either expressly or impliedly suggest claimed combination or the examiner must present a convincing line of reasoning as to why artisan would have found claimed invention to have been obvious in light of the references teachings.", the Examiner states the reference deals with the generalized problem of dispute resolution and therefore would be obvious to a person of ordinary skill in the art.

The applicant states that the prior art references does not teach the claimed feature of "a bid price of a competitor"

The Examiner responds that Burchetta discloses a successive series of demands and offers, the negotiation ending when preestablished parameters are met, the examiner contends that multiple offers are analogous to "bid price of a competitor".

See following rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3621

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1, 12, 13 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, 12, 13 and 17 recites the limitations "abstract mediating request" this claimed feature imposes no further limitation upon the claim since the term "abstract mediating request" is arbitrary.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloo (US Patent 5,895,450) in view of Burchetta et al. (US Patent 6,330,551) and Further in view of Reese (US Patent 6,236,980).

As per claim 1,

Sloo ('450) discloses a mediation negotiating method for mediating a negotiation between a requestor and responders by using an electronic network, comprising:

Forming a negotiation field, inputs said requesting conditions, and notifying via the network the requesting conditions to the responders selected in accordance with said requesting conditions; (Column 7, lines 66-67; column 8 lines 1-4 – Establishing a settlement, conditions of acceptance.)

a negotiation responding step which receives response information from the responders who participate in said negotiation field and notifies said requestor and the other responders of the received response information. (Column 8, lines 33-58; figure 7 – steps 718-724)

wherein the formation of the requesting conditions comprises analyzing an abstract mediation request from the requester to form said plurality of conditional items; and said plurality of conditional items includes conditional items formed from an inquiry to the requester, conditional items automatically formed from requester information, and conditional items calculated from value of already established request conditional items. (column 4, lines 61-67.)

Sloo ('450) does not explicitly disclose "a request forming step which forms requesting conditions including a plurality of conditional items in which priorities have been allocated to

Art Unit: 3621

request contents in response to a mediating request of said requestor”, Burchetta et al. (‘551) discloses “a request forming step which forms requesting conditions in which priorities have been allocated to request contents in response to a mediating request of said requestor”.(Column 2, lines 3-13; Figure 2 – label 24, entering and comparing demands). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo (‘450) method with the Burchetta et al. (‘551) method in order in order to improve the percentage of negotiations that are settled.

Sloo (‘450) does not explicitly disclose “arranged in accordance with the priorities of said request contents”, Reese (‘980) discloses “arranged in accordance with the priorities of said request contents”. (Figures 6 [item 156 ranking by stars] and 16 [356 ranking indicator]). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo (‘450) method with the Reese (‘980) method in order in order to improve the percentage of negotiations that are settled.

Sloo (‘450) discloses the claimed invention except for “plurality of conditional items “, It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a plurality of conditional items, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Claims 3, 12 and 13 are in parallel with claim 1 and are rejected for at least the same reasons.

As per claim 2,

Sloo (‘450) discloses a method according to claim 1

wherein in said request forming priorities are allocated to request articles or the request contents such as service, price, term of delivery, and the like, thereby forming the requesting conditions with said priorities as said requesting conditions.(Column 7, lines 66-67; column 8 lines 1-4; figure 3)

As per claim 4

Sloo (‘450) discloses a method according to claim 1

Sloo (‘450) does not explicitly disclose “an abstract mediating request from the requestor is analyzed and one or a plurality of requesting conditions are formed”, Burchetta et al. (‘551) discloses “ an abstract mediating request from the requestor is analyzed and one or a plurality of requesting conditions are formed”.(Column 7, lines 26-46). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo (‘450) method with the Burchetta et al. (‘551) method in order in order to improve the percentage of negotiations that are settled.

As per claim 5,

Sloo (‘450) discloses a method according to claim 1

Sloo (‘450) does not explicitly disclose “ the request contents including the priorities in the requesting conditions inputted into said negotiation field are changed and inputted again”,

Art Unit: 3621

Burchetta et al. ('551) discloses "the request contents including the priorities in the requesting conditions inputted into said negotiation field are changed and inputted again".(Figure 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negotiations that are settled.

As per claim 6,

Sloo ('450) discloses a method according to claim 1

Wherein in said negotiation requesting step, if there are a plurality of requesting conditions, the responder is selected under a condition that he corresponds to at least one of said plurality of requesting conditions, and the negotiation field between said requestor is formed.(Column 8, lines 5-19)

As per claim 7,

Sloo ('450) discloses a method according to claim 1

Wherein in said negotiation requesting step, a negotiation term is set into said negotiation field and the requesting conditions are inputted,(Figure 3) and in said negotiation responding step, the end of the negotiation is discriminated and the negotiation field is closed.(Figure 7)

As per claim 8,

Sloo ('450) discloses a method according to claim 7

wherein in said negotiation responding step, the negotiation field is closed by a negotiation decision instruction of said requestor or an expiration of the negotiation term.(Column 8, lines 44-58)

As per claim 9,

Sloo ('450) discloses a method according to claim 7

Sloo ('450) does not explicitly disclose "the negotiation term is extended on the basis of an instruction from the requestor", Burchetta et al. ('551) discloses "the negotiation term is extended on the basis of an instruction from the requestor".(Column 8, lines 40-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negotiations that are settled.

As per claim 10,

Sloo ('450) discloses a method according to claim 7

Sloo ('450) does not explicitly disclose "when conditions which negotiation responding step, have been preset are satisfied upon expiration of the negotiation term, the negotiation term is automatically extended", Burchetta et al. ('551) discloses "when conditions which negotiation responding step, have been preset are satisfied upon expiration of the negotiation term, the negotiation term is automatically extended".(Column 8, lines 40-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order in order to improve the percentage of negotiations that are settled.

Art Unit: 3621

As per claim 11,

Sloo ('450) discloses a method according to claim 10

Sloo ('450) does not explicitly disclose "when there is no response information or the number of response information does not reach a predetermined threshold value upon expiration of the negotiation term, the negotiation term is automatically extended", Burchetta et al. ('551) discloses "when there is no response information or the number of response information does not reach a predetermined threshold value upon expiration of the negotiation term, the negotiation term is automatically extended". (Column 8, lines 40-52). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order to improve the percentage of negotiations that are settled.

As per claim 14,

Sloo ('450) discloses a negotiation responding method comprising:

a receiving step which receives request information inputted into a negotiation field formed on a network ; (Column 7, lines 66-67; column 8 lines 1-4; figure 3)

Sloo ('450) does not explicitly disclose "a negotiation responding step which prepares an initial value, a pitch value, and a lowest value with respect to a bid price, first inputting response information in which the initial value has been set to said bid price, in the case where another response information of a cheap bid price is recognized in said negotiation field, again inputs response information in which the bid price has sequentially been corrected on a unit basis of said pitch value, and in the case where a bid price of a competitor is lower than said lowest value, stops the input of the response information and breaks off the negotiation.", Burchetta et al. ('551) discloses "a negotiation responding step which prepares an initial value, a pitch value, and a lowest value with respect to a bid price, first inputs response information in which the initial value has been set to said bid price, in the case where another response information of a cheap bid price is recognized in said negotiation field, again inputs response information in which the bid price has sequentially been corrected on a unit basis of said pitch value, and in the case where a bid price of a competitor is lower than said lowest value, stops the input of the response information and breaks off the negotiation.". (Column 4, lines 48-67). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Burchetta et al. ('551) method in order to improve the percentage of negotiations that are settled.

Sloo ('450) does not explicitly disclose "receiving via the network, response information from responders arranged in accordance with the priorities of the request contents inputted into the negotiation field", Reese ('980) discloses "receiving via the network, response information from responders arranged in accordance with the priorities of the request contents inputted into the negotiation field". (Figures 6 and 16). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Sloo ('450) method with the Reese ('980) method in order to improve the percentage of negotiations that are settled.

Claims 15 and 16 are in parallel with claim 14 and are rejected for at least the same reasons.

Art Unit: 3621

Conclusion

Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the examiner should be directed to John Winter whose telephone number is **(571) 272-6713**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **James Trammell** can be reached at **(571) 272-6712**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to:

(703) 305-7687	[Official communications; including After Final communications labeled "Box AF"]
(703) 308-1396	[Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Examiner in the Knox Building, 50 Dulany St. Alexandria, VA.

JMW
November 28, 2005

John Winter
PRIMARY EXAMINER